

Patent
238/117

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Anticipated Classification of this application:

Class 424 Subclass 009.360

Prior application: 424-009.360

Examiner: Hollinden, G.

Art Unit: 1211

BOX PATENT APPLICATION
Assistant Commissioner for Patents
Washington, D.C. 20231

FILING UNDER 37 CFR 1.53(B)

This is a request for filing for a

☒ continuation ☐ divisional

application under 37 CFR 1.53(b) of pending prior application Serial No. 08/604,778
filed on February 23, 1996, which will issue as U.S. Patent No. 5,833,947 on
November 10, 1998 of

Scott M. Rocklage, Los Gatos, California; John Kucharczyk, Mill Valley, California;
Michael E. Moseley, San Francisco, California

for: "IMPROVEMENTS IN AND RELATING TO MAGNETIC RESONANCE
IMAGING"

1. COPY OF PRIOR APPLICATION AS FILED WHICH IS ATTACHED

☒ I hereby verify that the attached papers are a true and complete copy of what is shown
in my records to be the above-identified prior application, including the oath or
declaration as originally filed. (37 CFR 1.53)

24 Pages of Specification

5 Pages of Claims

 Pages of Abstract

7 Sheets of Drawings

formal ☒ informal

CERTIFICATE OF MAILING
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the
United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee'
in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

EM542084155US
Express Mail Label No.

November 09, 1998
Date of Deposit

Rowena R. Estrada
Name of Person Mailing Paper

Rowena R. Estrada
Signature of Person Mailing Paper

JC523 U.S. PTO
09/189043
11/09/98

#5A
#KID
6-18-99

3 Pages of Declaration and Power of Attorney
Small Entity Statement

- ☒ In accordance with the indication required by 37 CFR 1.53(b), my records reflect that the original signed declaration showing applicant's signature was filed on October 30, 1992 under Serial No. 07/946,373.
- ☒ Any amendment referred to in the declaration filed to complete the prior application, and I hereby state, in accordance with the requirements of 37 CFR 1.53(b), that such amendment did not introduce new matter therein.

Additional enclosures:

Parent Application Serial No. 08/604,778 was filed as a divisional of Application Serial No. 08/306,221 (filed September 14, 1994), which was a continuation of Application Serial No. 07/946,373 (filed October 30, 1992), which in turn was filed pursuant to 35 U.S.C. § 371 as a national stage application deriving from PCT Application No. PCT/EP91/00443 (filed March 6, 1991 and published as No. WO 91/14186). In addition to a copy of the application as originally filed in parent Serial No. 08/604,778, enclosed herewith are true copies of what are shown in my records to be the following documents relating to the PCT/EP91/00443 International Application, all of which were submitted to the PTO on February 23, 1996 in connection with the filing of Serial No. 08/604,778:

1. The cover sheet to the No. WO 91/14186 publication (as published September 19, 1991);
2. The associated PCT (EPO) International Search Report (dated July 12, 1991);
3. The WIPO Notice of Communication of International Application to Designated Offices (dated September 19, 1991); and
4. The PCT (EPO) Notification of Transmittal of International Preliminary Examination Report, and the associated Report, with annexes (dated June 23, 1992).

2. **AMENDMENTS**

- ☒ Cancel in this application original Claims 5-7, 9-20 and 25-27 of the prior application before calculating the filing fee, without prejudice to resubmission of such claimed subject matter in alternative format. (At least one original independent claim must be retained for filing purposes.)
- ☐ A Preliminary Amendment is enclosed. (Claims added by Amendment must be numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

08/604,778

3. **INFORMATION DISCLOSURE STATEMENT**

☐ An Information Disclosure Statement, PTO 1449, and references are submitted herewith.

4. **PETITION FOR SUSPENSION OF PROSECUTION FOR THE TIME TO FILE AN AMENDMENT**

☐ There is provided herewith a PETITION FOR SUSPENSION OF PROSECUTION FOR THE TIME NECESSARY TO FILE AN AMENDMENT (NEW APPLICATION FILED CONCURRENTLY).

5. **FEE CALCULATION**

BASIC FILING FEE:				\$790.00
Total Claims	9	- 20	= 0 x \$22	\$0.00
Independent Claims	4	- 3	= 1 x \$82	\$82.00
Multiple Dependent Claims			\$270 (if applicable)	
Surcharge 37 CFR 1.16(e)			\$130 (if applicable)	
TOTAL OF ABOVE CALCULATIONS				\$ 872.00
Reduction by ½ for Filing by Small Entity. Note 37 CFR 1.9, 1.27, 1.28. If applicable, Verified Statement must be attached.				
Misc. Filing Fees (Recordation of Assignment)				
TOTAL FEES SUBMITTED HEREWITH				

☒ The fee for extra claims is not being paid at this time.

Filing Fee Calculation \$872.00

6. **SMALL ENTITY STATUS**

☐ A Verified Statement to establish small entity under 37 CFR 1.9 and 1.27 is attached

☐ has been filed in the prior application and such status is still proper and desired. [37 CFR 1.28(a)]

Filing Fee Calculation (50% of above) -----

7. **DRAWINGS**

[NOTE: DO NOT CHECK THIS IF PRIOR CASE IS NOT TO BE ABANDONED.]

- ☐ Transfer the drawings from the prior application to this application and, subject to Item 16 below, abandon said prior application as of the filing date accorded to this application. A duplicate copy of this request is enclosed for filing in the prior application file.
[May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record authorized by 37 CFR 1.138 and before payment of issue fee.]

- ☐ Transfer the following sheet(s) of drawings from the prior application to this application.

- ☐ New drawings are enclosed ☐ formal ☐ informal

8. PRIORITY - 35 U.S.C. 119

- ☐ Priority of application Serial No. _____ filed on _____ in _____ [country] is claimed under 35 U.S.C. 119.
- ☐ The certified copy has been filed in prior U.S. application Serial No. _____ on _____.
- ☐ The certified copy will follow.

9. RELATE BACK - 35 U.S.C. 120

- ☒ Amend the Specification by inserting before the first line the following paragraph:
- This is a continuation of co-pending application Serial No. 08/604,778 (filed February 23, 1996, now Patent No. 5,833,947), which was a divisional of application Serial No. 08/306,221 (filed September 14, 1994, now Patent No. 5,494,655), which was a continuation of application Serial No. 07/946,373 (filed October 30, 1992, abandoned). Serial No. 07/946,373 was filed pursuant to 35 U.S.C. § 371 as a national stage application deriving from PCT Application No. PCT/EP91/00443 (filed March 6, 1991, Publication No. WO 91/14186), and is a continuation-in-part of application Serial No. 07/490,859 (filed March 9, 1990, now Patent No. 5,190,744).--

10. INVENTORSHIP STATEMENT

- ☒ With respect to the prior co-pending U.S. application from which this application claims benefit under 35 U.S.C. 120, the inventor(s) in this application is (are):
- ☒ the same
- ☐ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:
- [type name(s) of inventor(s) to be deleted]
- ☒ The inventorship for all the claims in this application are:

- ☒ the same
- ☐ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

11. **ASSIGNMENT**

- ☒ The prior application is assigned of record to The Regents of the University of California. (A copy of the assignment, recorded at Reel/Frame 7238/0001, is enclosed.)
- ☐ An Assignment of the invention to _____ is attached.

12. **FEE PAYMENT BEING MADE AT THIS TIME**

- ☒ Not attached. No filing fee is submitted. [This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently.]
- ☐ Attached.
- ☐ Filing fee. -----
- ☐ Recording assignment. [\$40.00 37 CFR 1.21(h)(1)] -----
Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached.
[\$130.00; 37 CFR 1.47 and 1.17(h)] -----
- ☐ Petition fee to Suspend Prosecution for the Time Necessary to File an Amendment (New Application Filed Concurrently).
[\$130.00; 37 CFR 1.103 and 1.17(i)(1)] -----
- ☐ For processing an application with a specification in a non-English language.
[\$130.00; 37 CFR 1.52(d) and 1.17(k)] -----
- ☐ Processing and retention fee.
[\$130.00; 37 CFR 1.53(d) and 1.21(l)] -----

Total Fees Enclosed -----

13. **METHOD OF PAYMENT OF FEES**

- ☐ Attached is a check in the amount of _____.
- ☐ Charge Deposit Account No. **12-2475** in the amount of _____.

14. AUTHORIZATION TO CHARGE ADDITIONAL FEES

The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Deposit Account No. **12-2475**:

- ☐ 37 CFR 1.16 (filing fees)
- ☐ 37 CFR 1.16 (presentation of extra claims)
- ☐ 37 CFR 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☐ 37 CFR 1.17 (application processing fees)
- ☐ 37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b))

15. INSTRUCTIONS AS TO OVERPAYMENT

- ☒ Credit Deposit Account No. **12-2475**.
- ☐ Refund

16. POWER OF ATTORNEY

- ☐ The power of attorney in the prior application is to
- ☒ The power of attorney in the prior application is to the registered attorneys listed below and members of or associates in the law firm of **LYON & LYON LLP**, 633 West Fifth Street, 47th Floor, Los Angeles, California 90071, Registration No. 11,611, whose members are registered to practice in the U.S. Patent and Trademark office:

Roland N. Smoot, Reg. No. 18,718
Conrad R. Solum, Jr., Reg. No. 20,467
James W. Geriak, Reg. No. 20,233
Robert M. Taylor, Jr., Reg. No. 19,848
Samuel B. Stone, Reg. No. 19,297
Douglas E. Olson, Reg. No. 22,798
Robert E. Lyon, Reg. No. 24,171
Robert C. Weiss, Reg. No. 24,939
Richard E. Lyon, Jr., Reg. No. 26,300
John D. McConaghy, Reg. No. 26,733
William C. Steffin, Reg. No. 26,811
Coe A. Bloomberg, Reg. No. 26,605
J. Donald McCarthy, Reg. No. 25,119
John M. Benassi, Reg. No. 27,483
James J. Shalek, Reg. No. 29,749
Allan W. Jansen, Reg. No. 29,035
Robert W. Dickerson, Reg. No. 29,914
Roy L. Anderson, Reg. No. 30,240
David B. Murphy, Reg. No. 31,125

James C. Brooks, Reg. No. 29,898
Jeffrey M. Olson, Reg. No. 30,790
Steven D. Hemminger, Reg. No. 30,755
Jerrold B. Reilly, Reg. No. 32,293
Paul H. Meier, Reg. No. 32,274
John A. Rafter, Jr., Reg. No. 31,653
Kenneth H. Ohriner, Reg. No. 31,646
Mary S. Consalvi, Reg. No. 32,212
Lois M. Kwasigroch, Reg. No. 35,579
Lawrence R. LaPorte, Reg. No. 38,948
Robert C. Laurenson, Reg. No. 34,206
Carol A. Schneider, Reg. No. 34,923
Hope E. Melville, Reg. No. 34,874
Michael J. Wise, Reg. No. 34,047
Richard J. Warburg, Reg. No. 32,327
Kurt T. Mulville, Reg. No. 37,194
Theodore S. Maceiko, Reg. No. 35,593
Bruce G. Chapman, Reg. No. 33,846
F.T. Alexandra Mahaney, Reg. No. 37,668
Reg. No. _____

- ☒ The power appears in the original papers in the prior application.
- ☐ The power does not appear in the original papers, but was filed on _____ in this application.
- ☐ A new power has been executed and is attached.
- ☒ Address all future communications to:

LYON & LYON LLP
633 West Fifth Street, 47th Floor
Los Angeles, California 90071
(213) 489-1600
Attention: Paul H. Meier, Esq.

17. MAINTENANCE OF CO-PENDENCY OF PRIOR APPLICATION

- ☐ A petition, fee and response has been filed to extend the term in the pending **prior** application until _____. A copy of the petition for extension of time in the **prior** application is attached.

18. CONDITIONAL PETITIONS FOR EXTENSION OF TIME IN PRIOR APPLICATION

- ☐ A conditional petition for extension of time is being filed in the pending **prior** application. A copy of the conditional petition for extension of time in the **prior** application is attached.

19. ABANDONMENT OF PRIOR APPLICATION

- ☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application co-pending with said prior application. At the same time, please add the words "now abandoned" to the amendment of the specification set forth in Item 13 above.

Respectfully submitted,

LYON & LYON LLP

Dated: November 9, 1998

By: Paul H. Meier
Paul H. Meier
Reg. No. 32,274

633 West Fifth Street, Suite 4700
Los Angeles, California 90071-2066
(213) 489-1600

Enclosures

The Regents of the University of California
Name of Assignee

1111 Franklin Street – 5th Floor
Oakland, CA 94607
Address of Assignee

Assignment recorded in PTO on May 18, 1993, Reel 7238, Frame 0001

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